

REMARKS / DISCUSSION OF ISSUES

Claims 1-10 are pending in the application. No amendments are made to the claims, and thus a listing under Rule 121 is not required.

Rejections under 35 U.S.C. § 102

Claims 1, 2 and 6-9 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Hanaoka* (Patent Abstracts of Japan 2003031355). For at least the reasons that follow, Applicants respectfully submit that the rejection is improper and should be withdrawn.

a. Rejection improperly relies only on English language abstract

The rejection relies on the referenced Patent Abstract of Japan and does not appear to rely upon the underlying patent document. Notably, there are reference characters listed in the substantive aspect of the rejection, and some of these reference characters are not depicted in the representative drawing of the Abstract (e.g., element 21). Moreover, there appears to be reference to paragraphs [0020-0026], which are also not part of the Abstract. The undersigned has reviewed the file history in the PAIR system and has not uncovered the underlying document (JP 2003031355) either in its native language or a translation thereof from Japanese. Rather, the Abstract appears to have been cited in the EP Search Report of the priority application of the present application. The undersigned attempted, without success, to garner a copy of the underlying document from the EP database and a US counterpart of JP 2003031355. However, because it appears that the rejection relies on the Abstract and does not rely on a translation of the underlying document, the rejection is improper. To this end, MPEP § 706.02 states, in relevant part (with emphasis added):

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. **Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is**

generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished). To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. **Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a).**

Thus, Applicants respectfully submit that because it appears that only the Abstract was relied upon in the rejection, the rejection of claims 1, 2 and 6-9 is improper and should be withdrawn. Moreover, any further rejections of the claims cannot be properly made final.

b. Abstract does not provide a clear description of the representative drawing

The above notwithstanding, the rejection nonetheless fails to comply with MPEP § 706, which states, in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity (emphasis added).

Applicants respectfully submit that they are unable to formulate a meaningful substantive response (either traversal, or amendment, or both) because of deficiencies in the Abstract. To this end, the English language abstract describes a display panel. However, the Abstract does not include a single reference character and therefore does not allow Applicants to garner a clear understanding of the structure shown in the representative drawing of the Abstract. As such, Applicants are placed in the prejudicial position of having to attempt to discern the relevance of the applied art. Thus, a proper rejection under MPEP § 706 has not been provided.

Therefore, because a proper rejection under MPEP § 706 has not been provided, Applicants submit that a *prima facie* case of anticipation has not been established. Accordingly, any further rejections of the claims cannot be properly made final.

Rejections under 35 U.S.C. § 103

Claims 3-5 and 10 were rejected under 35 U.S.C. § 103(a) in view of *Hanaoka* in view of secondary and tertiary references. While Applicants do not concede the propriety of the rejections, for at least the reasons set forth above, Applicants respectfully submit that in present form, *Hanaoka* is not properly applied and cannot serve as a basis of a rejection.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/s/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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